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In re Application of
SABANATHAN, Thirumani
Application No.: 09/762,692
PCT No.: PCT/GB98/00652
Int. Filing Date: 03 March 1998
Priority Date: 30 April 1997
Attorney Docket No.: 007-001
For: OCCLUSION DEVICE

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on applicant's "Second Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 15 January 2003.

BACKGROUND

On 03 March 1998, applicant filed international application no. PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 November 1998.

A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and a petition seeking revival under 37 CFR 1.137(b) with the appropriate fee. The petition was dismissed in a decision dated 24 May 2001 because the delay was not considered to be unintentional.

On 24 September 2001, applicant responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 February 2002 because the delay was not considered to be unintentional.

On 10 June 2002, applicant responded to the 15 February 2002 decision by filing the "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 November 2002 because the delay was not considered to be unintentional.

On 15 January 2003, applicant filed "Second Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b)."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 08 June 1995).

Applicant has satisfied items (1) and (2), as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regards to item (3) above, a review of the present renewed petition reveals that applicant has not provided the necessary evidence that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. In the Petition to Revive dated 09 February 2001, Mark Lunt declared that, "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Mr. Lunt's statement was construed as being a deliberately course of action to not persist in seeking the revival of the abandoned application. In the Renewed Petition to Revive filed 24 September 2001, petitioner asserted that Mr. Lunt did not have the authority to abandon the application without the consent of Ms. Sabanathan. In a decision dated 15 February 2002, the Office of PCT Legal Administration held that "Mr. Lunt had authority to prosecute (or not prosecute) the application and Ms. Sabanathan is bound by the actions of Mr. Lunt." In a decision dated 15 November 2002, the Office of PCT Legal Administration held that the papers showed that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application and that the entire delay could not held to be unintentional.

As stated in Manual of Patent Examining Procedure, 711.03(c)(E):

The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See *Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under 37 CFR 1.137, unless the third party

has reassigned the application to the applicant prior to the due date for the reply. *Id.*

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See *Winkler*, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See *Futures Technology Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

Petitioner states in the present petition that "Bradford Hospital's authority to prosecute the patent applications was not absolute and unfettered" and that "it (USPTO) completely ignores the relevant facts that Mrs. Sabanathan granted only conditional authority to Bradford Hospital to prosecute patent application . . ." The evidence presented has been carefully reviewed and as stated in the previous Decision(s), the papers show that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application. Additionally, Thirumunani Sabanathan states in her declaration that "if I cooperated with any patent application, then Bradford would pay for prosecuting the PCT Application, including Mr. Lunt's fee, and in the event the invention was commercialized and that I would share royalties equally with Bradford." Further, in Susan E. Clark's letter dated 31 March 1998 to David Jackson, Chief Executive of Bradford Hospital, states that "[a]s I understand it, any financial benefit obtained through the commercial development of the device, the exploitation of a patent or any other commercial interest in the product would be split 50:50 between the Trust and the Sabanathan estate." Therefore, Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute (or not prosecute) the above identified application.

Additionally, petitioner states, "[t]he June 6, 2000 agreement was irrelevant to the Entitlement Proceedings" and that the agreement between Bradford Hospital and Mrs. Sabanathan not to contest the entitlement proceeding does not negate the U.K. Patent Office's finding. The Office of PCT Legal Administration is not negating the findings of the U.K. Patent Office or asserting that Mrs. Sabanathan is not the true owner of the above-identified application. As stated above, Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and the that Bradford Hospital NHS Trust had the authority to prosecute (or not to prosecute) the above identified application, therefore, ownership of the invention is not relevant to this matter.

Lastly, petitioner states, "applicant did not delay in filing the petition to revive." However, as stated in the previous decision, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999. On 06 June 2000, Thurumani Sabanathan executed "Agreement" which states that "the Foundry acknowledges that it is aware that the period within which national/regional phase entry of the international application no. PCT/GB98/00653 must normally be effected may have passed with such phases having entered and therefore such application may not exist . . ." Upon execution of the agreement, Mrs. Sabanathan became aware of the abandonment of application no. PCT/GB98/00653 and should have filed a petition to revive under 37 CFR 1.137 to protect her rights in the invention. Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

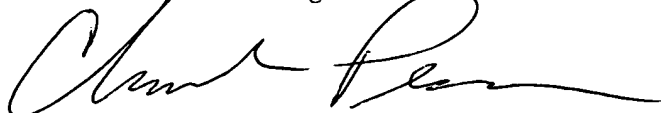
Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.137(b) is DENIED.

This decision may be viewed as a final agency decision. See MPEP 1002.02.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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